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EXAMINER

JOHNSON, S

ART UNIT

PAPER NUMBER

3641

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DATE MAILED: 07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/483,467

Applicant(s)
Danner et al.

Examiner
Stephen M. Johnson

Art Unit
3641



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 11, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-43, 45-61, and 64-90 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-43, 45-61, and 64-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 11, 2001 is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on May 11, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 18 20) ☐ Other: _____

Art Unit: 3641

1. The proposed drawing corrections or additional amended drawings (filed on 5/11/2001) are approved.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “the firing pin plug is a threaded firing pin adjustment screw adapted to fit into a threaded aperture in the rear end of the bolt plug” and “the firing pin at a forward end of the firing pin assembly operatively connected to the firing pin plunger” (see claim 5); the “at least two electrodes” (see claim 14); the secondary discharge path (see claim 31) must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.
4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Language in claims 33 and 36 directed to “power emanating from the voltage supply means in excess of a predetermined level” and “power emanating from the voltage increasing means in excess of a predetermined level”.
5. Claims 1-9, 11-37, 46, 55, 60-61, 64-69, 75, 82, and 85-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3641

trigger pull

In claim 1, section iii, how is the phrase “a trigger” intended to relate to the previously claimed “trigger assembly” (see claim 1, line 8)? In claim 2, line 5, how is the term “a movable firing pin assembly” intended to relate to the previously claimed “firing pin” (see claim 1, line 8)? In claim 3, line 6, how is the term “a firing pin” intended to relate to the previously claimed “firing pin” (see claim 1, line 8)? In claim 3, lines 7-8, how is the term “a firing pin spring” intended to relate to the previously claimed “firing pin spring” (see claim 2, line 6)? In claim 3, lines 20-21, how is the term “a trigger assembly” intended to relate to the previously claimed “a trigger assembly” (see claim 1, line 8)? In claim 3, lines 24-25, the phrase “the bolt plug detent” lacks an antecedent. In claim 46, the phrase “the voltage increasing means” lacks an antecedent. In claim 55, lines 1-2, the phrase “said system control means” lacks complete agreement with its antecedent. In claim 60, line 8, use of the phrase “any of a series of monitored operative conditions” makes the claim indefinite as to whether only the subsequently claimed conditions are intended or if any condition is intended. In claim 75, line 8, what conditions are intended to be inclusive in the term “any operative condition”? In claim 82, line 3, the phrase “a safe position” should be claimed as ‘said safe position’ if the previously claimed safe position is intended. In claim 85, last line, how is the phrase “a conductive firing pin” intended to relate to the previously claimed firing pin (claim 85, line 12). In claim 85, line 12, the phrase “said firing pin” lacks an antecedent. In claims 86 and 87, the phrase “the voltage increasing means” lacks an antecedent.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

Art Unit: 3641

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood as to how the claimed structure “the firing pin plug is a threaded firing pin adjustment screw adapted to fit into a threaded aperture in the rear end of the bolt plug” and “the firing pin at a forward end of the firing pin assembly operatively connected to the firing pin plunger” can interact with the structure claimed in claim 3 and illustrated in fig. 4 to form a functional device.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 38-43, 45-61, and 64-90 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim language in claim 38, section d), directed to “unauthorized activation of the firearm” as used in combination with the claim language of claim 38; directed to “monitoring the capacity of the voltage supply means” (see claim 42); directed to “the firearm being in a sleep

Art Unit: 3641

mode”; “unauthorized activation of the firearm” and “failure of any electronically operated components of the firearm” as used in combination with the claim language of claim 47; directed to “programming for performing an operational sequence to monitor and control the firearm” (see claims 58 and 83); directed to “failure of any of a series of monitored operative conditions” (see claim 60); directed to “the firearm being in a sleep mode”; “unauthorized activation of the firearm”; “failure of any electronically controlled and operated components of the firearm”; “failure of any programmed condition to be met” as used in combination with the claim language of claim 60; directed to “the firearm being in a sleep mode”; “failure of any electronically controlled and operated components of the firearm”; “failure of any programmed condition”; “unauthorized activation of the firearm” as claimed in combination with the claim language of claim 70; directed to “the firearm being in a sleep mode”; “failure of any electronically controlled and operated components of the firearm”; “failure of any programmed condition”; “unauthorized activation of the firearm” as claimed in combination with the claim language of claim 73; directed to “in response to failure of any operative condition required for firing the firearm” as claimed in combination with the claim language of claim 75; directed to “the firearm being in a sleep mode”; “failure of any electronically controlled and operated components of the firearm”; “unauthorized activation of the firearm” as claimed in combination with the claim language of claim 76; directed to “the firearm being in a sleep mode”; “failure of any electronically controlled and operated components of the firearm”; “failure of any programmed condition”; “unauthorized activation of the firearm” as claimed in combination with the claim language of claim 85; and directed to

Art Unit: 3641

“performing an operational sequence to monitor and control the firearm” as claimed in combination with the claim language of claim 90 are **unsupported by the application as originally filed**.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 75 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific operative conditions of the firearm, does not reasonably provide enablement for “any operative condition” of the firearm. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The specification provides support for specific operative conditions whose failure will result in the firearm being disabled. For example “the bolt being in the open or unlocked position” or “the safety being in the safe position”. It does not provide support for **any** unspecified operative condition of the firearm.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3641

13. Claims 70-72, 75-88, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Harthcock.

Harthcock discloses a firearm and method for firing comprising:

- a) monitoring a sequence of operations with a system control, col. 5, lines 36-42
- b) sending a signal to the system control upon activation of a trigger, col. 6, lines 57-59
- c) isolating and preventing the firing pin from receiving power, col. 5, lines 36-48,
col. 7, lines 3-10
- d) a selected condition being insufficient energy to initiate firing col. 5, lines 36-37
a round or voltage below a predetermined level,
- e) transmitting power to the firing pin from the voltage source and col. 5, lines 43-54
applying power to the round of ammunition.

14. Applicant's arguments are addressed as follows. It is argued that Harthcock does not appear to disclose a system that actively monitors the firearm upon receiving a trigger signal to monitor a series of pre-programmed conditions or parameters. In response, it should be noted that all applicant has claimed is "monitoring a sequence of operative conditions with a system control" (see claim 73) and that this condition is met by col. 5, lines 36-42 of Harthcock. It is further argued that Harthcock does not "isolates and prevents the electrically conductive firing pin from receiving a firing pulse upon the detection or failure of any one of a series of preprogrammed conditions or parameters". In response it should be noted that Harthcock explicitly recites

Art Unit: 3641

“control processor 31 controls all functions of the handgun” (see col. 5, lines 18-19). Harthcock also recites “The control processor 31 sends a firing signal to a fire control generator 48 which comprises a power frequency generator 49 ... and an electronic firing mechanism 53”. In col. 5, lines 60-68 and col. 6, lines 1-5, Harthcock describes monitoring via sensors 43 and transducer 61 to determine when the next round is fired. Clearly Harthcock not only monitors but also activates the electrically fired firing pin upon what is sensed regarding the operational condition of the firearm. With regard to the argument that the Harthcock firearm will send power to the round to fire the weapon without actively monitoring the state of the firearm, clearly this is not the case for the reasons already argued (col. 5, lines 60-68 and col. 6, lines 1-5). It is argued that Harthcock is designed to provide memory and feedback of the firing of the weapon and not to actively monitor the firearm. Clearly Harthcock not only provides memory and feedback but also actively monitors or controls the firearm as explicitly stated (see col. 5, lines 17-19; col. 5, lines 45-68; col. 6, lines 1-5; col. 6, lines 26-39; col. 6, lines 63-69; col. 7, lines 3-8; col. 8, lines 2-4; and col. 4, lines 59-64). Once again applicants argument that all that processor 31 does is to record data and not to control a firing operation of the firearm is not a correct interpretation of the Harthcock reference (see col. 5, lines 17-19; col. 5, lines 45-68; col. 6, lines 1-5; col. 6, lines 26-39; col. 6, lines 63-69; col. 7, lines 3-8; col. 8, lines 2-4; and col. 4, lines 59-64).

15. Claims 1-9, 11-43, 45-61, and 64-90 are rejected under 35 U.S.C. 251.

Whatever the reason that the claims were originally allowed must be retained in any reissue claims, since applicant has “surrendered” claiming his invention of a scope which lacks the

Art Unit: 3641

“reasons-it-was allowed limitations”. In this case the parent case (08/680,490) makes it clear that, “a switch isolation means for isolating the firing pin and voltage supply, responsive to the claimed conditions” (see claims 1 and 38); “an electronic safety which is responsive to the firearm safety being activated, serving to isolate the firing pin and the trigger pull signal” (see claims 1 and 38).

All reissue claims must retain those limitations (see MPEP 1412.02).

16. Applicant’s arguments are addressed as follows. Applicant argues that since there is no prosecution history and no action by applicant to overcome a rejection, that in this case, a recapture rejection is not proper. In response, there are several different instances upon which a recapture rejection is appropriate only some of which are directed to actions by applicant to overcome a rejection made by the Office. Recapture rejections are also appropriate when a Reasons for Allowance was made in the prosecution history and this Reasons for Allowance was not contested prior to issuance of the patent. This is the aspect of Recapture rejection that the examiner is relying upon. In this case the only prosecution history that is relevant to this rejection is the Reasons for Allowance and the fact that the Reasons for Allowance were not contested prior to issuance of the patent. With regard to the argument that neither applicant or the Office did anything to affirmatively limit or surrender specific subject matter of the claims, the Office did so via the Reasons for Allowance. Applicant did so via his silence after receiving the Reasons for Allowance. With regard to the argument that “Failure to file such a statement does not give rise to any implication that the applicant or patent owner agrees with or acquiescence in the reasoning of the Examiner”, such a statement merely states that applicant may not agree with the examiner’s

Art Unit: 3641

reasoning. It does not preclude such a statement as being the reason relied upon in the prosecution history that the claims were in fact allowed by the examiner. With regard to the argument that use of Reason for Allowance would in fact block all reissue procedure and/or practice, this is not the case because applicant can contest the Reasons for Allowance prior to issuance of the patent.

17. Any inquiry concerning this communication should be directed to Stephen M. Johnson at telephone number (703)-306-4158.



STEPHEN M. JOHNSON
PRIMARY EXAMINER